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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/086,124      | 02/28/2002  | Seiji Tatsuta        | 02130/LH            | 2244             |

1933 7590 04/23/2003

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[REDACTED] EXAMINER

NGUYEN, KIMBERLY D

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2876

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                |                  |
|------------------------------|--------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.                | Applicant(s)     |
|                              | 10/086,124                     | TATSUTA ET AL.   |
|                              | Examiner<br>Kimberly D. Nguyen | Art Unit<br>2876 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_ is/are allowed.

6) Claim(s) 1-23 is/are rejected.

7) Claim(s) \_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### ***Information Disclosure***

2. Related application serial no. 09/655,348 citations have been crossed out because they are part of an unpublished application not yet a public document.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,186,405 (hereinafter "Patent '405") in view of U.S. Patent No. 5,896,403 (hereinafter "Nagasaki"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somewhat broader recitation of the Patent '405. For instance, the present invention and the Patent '405, the Applicants claim a code reader comprising:

“an image pickup section to pick up said code”, whereas in Patent ‘405, the applicant claims “reading means for picking up and optically reading an image...”; “a restoration section to specify the code...”, whereas in Patent ‘405, the applicant claims “restoration means for processing...”

In view of Nagasaki, the present invention and the Patent ‘405, the Applicants claim a code reader comprising:

“a guide section...”, whereas Nagasaki teaches “change in optical path length between the code 36 and the detection section 44 to specify positional relationship between the image and the code (see figs. 3 and 9; col. 14, lines 18-48)”, which serves as “a guide section...”;

“a code detection...”, whereas Nagasaki teaches “a code detection area 44 is determined based on an alignment error/aligning direction (col. 48, line 59 through col. 49, line 9)”.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teachings of claim 4 of Patent 405 and in view of Nagasaki’s teachings of “a guide section and a code detection...” to perform the same functions as claimed by the present application. The instant claim obviously encompasses the claimed invention of Patent ‘405 in view of Nagasaki’s teachings.

The obvious-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ (CCPA 1970). A timely filed terminal disclaimer is compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 7-12, 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaki et al. (US 5,896,403; hereinafter “Nagasaki”).

Re claims 1, 10-12, 21-23: Nagasaki discloses a code reader (see fig. 1) to read a code from a data recording medium (30 in fig. 2A; col. 9, lines 36-43) which records data as an optically readable code and is provided with a non-interference area (174, 176 and 178 in fig. 16; col. 18, line 59 through col. 19, line 3) around the code to prevent presence of only an interference image having an attribute causing an error during reading of the code, the code reader comprising:

an image pickup section 44D to pickup the code (fig. 3; col. 10, lines 9-18);  
a guide section configured to specify positional relationship between the image pickup section and the code (i.e., change in optical path length between the code 36 and the detection section 44; see figs. 3 and 9; col. 14, lines 18-48);

a code detection section 44 to set a code detection area in an image pickup screen obtained in the image pickup section and detect at least part of the code from the inside thereof (fig. 3; col. 10, lines 9-18); and

a restoration section (restoring means) to specify the code from the image pickup screen based on a detection position of at least part of the code detected in the code detection section and restore data recorded in the code (col. 3, line 39 through col. 4, line 17).

the code detection area 44 is determined based on an alignment error/aligning direction (col. 48, line 59 through col. 49, line 9) between the image pickup section and the code due to the guide section and a specification of the code.

Although, Nagasaki does not specifically disclose a code reader as claimed in this invention; Nagasaki teaches an overall code reader, which meets all of the above limitations as claimed in this instant invention.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made modify the teachings of Nagasaki, (such as the change in optical path length between the code and the detection section) in order to provide a better, more accurate reading within the reader. Furthermore, such modification of employing, changing in optical path length and/or aligning error to the teachings of Nagasaki would have been an obvious expedient.

Re claims 7, 18: Nagasaki teaches a code reader to read code from a data recording medium (30 in fig. 2A), wherein the non-interference are (174, 176, 178 in fig. 16) is inherently widened on one of upper side and lower side of the code (see fig. 16), and the code detection section obviously starts detection from the wider side of the non-interference area (174, 176, 178 in fig. 16) and terminates detection when detecting part of the code (col. 10, lines 19-44).

Re claims 8-9, 19-20: Nagasaki teaches a code reader to read code from a data recording medium, wherein the code (36 in fig. 2) comprises a plurality of blocks (38 in fig. 2; col. 9, lines 36-43), each of the blocks comprises an arrangement of a data area containing data divided from the data, a marker area containing a marker for identifying that block (38D and 38E in fig. 2A for x and y addresses respectively; col. 9, lines 41-43), and inherently identifying that block, according to a specified positional relationship, at least part of the code (36 in fig. 2) detected in

the code detection section is the marker (38A in fig. 2; col. 9, lines 39-43), and restoration section specifies the code from the image pickup screen in units of blocks and restores the divided data (col. 2, line 46 through col. 3, line 15).

7. Claims 2-6, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagasaki in view of Kovach et al. (US 5,105,073; hereinafter "Kovach"). The teachings of Nagasaki have been discussed above.

Nagasaki fails to teach or fairly suggests the guide section allows part thereof as a guide positioning section to touch a recording medium positioning section as part of the recording medium and determines a positional relationship between the image pickup section and the code.

Kovach teaches a credit card reader/extender 38 having a guide section 42, 44 allows part thereof as a guide positioning section (bottom edge 60 and internal wall 62 in figs. 2-5) to touch a recording medium as part of the recording medium (20 in fig. 2) and determines a positional relationship between the reader and the code (col. 1, lines 6-16; col. 3, line 44 through col. 4, line 23).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the positioning guidance through an optical credit card reader as taught by Kovach to the teachings of Nagasaki to further ensure a proper presentation of the card in the card reader (col. 3, lines 44-51) and to provide a more accurate reading communication between the card and the card reader. Such modification would have been an obvious matter of design variation, i.e. to integrate the positioning guidance of the card to the teachings of Nagasaki, well within the ordinary skill in the art, and therefore an obvious expedient.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 703-305-1798. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-1341 for regular communications and 703-305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-8792.

KDN  
April 18, 2003



THIEN M. LE  
PRIMARY EXAMINER